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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,291	04/09/2004	Teresa Amorin	1219309-0003	1104

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WHITE & CASE LLP  
PATENT DEPARTMENT  
1155 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036

EXAMINER

LEE, GUNYOUNG T

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

EF

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/821,291		AMORIN, TERESA	
	<b>Examiner</b>		<b>Art Unit</b>	
	Gunyoung T. Lee		2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 34-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 23-33 is/are rejected.
- 7) ☒ Claim(s) 12-22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed on October 13, 2006 has been entered:
  - Claims 1, 2, 5, 12, 14 and 21 have been amended.

### ***Claim Objections***

2. Claims 12-21 are objected to because of the following informalities:
  - On line 6 of claim 12, "the hollow" lacks antecedent basis;
  - "The illumination device" at the beginning of claims 13-21 lacks antecedent basis.Appropriate corrections are required.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

4. Claims 1-3, 5-10, 23 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Hill (US 5,764,132).
5. In regard to claims 1, 7 and 23, Hill discloses a lighting device having:
  - A light source (26);
  - A power supply (28) coupled to the light source (26);
  - A housing (Fig. 3) containing the light source (26) and the power supply (28), for insertion into an interior portion of an article (12) having a preselected shape (a box shape with a rectangular cross-section as shown in Fig. 1), the housing having a shape (a box shape as shown in Fig. 3) substantially similar to the

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shape of the article (12) into the interior of which the light source is inserted/attached (col. 2, lines 2-7);

- Wherein, the housing (Fig. 3) having an interior and an aperture therein for a passage of light (the passage of a light from the recessed light bulb/source is clearly shown in Fig. 1);
- A light source (26) residing in the interior of the housing;
- A switch (30) coupled to the power supply (28);
- Wherein, when the switch (30) is actuated, the light source (26) is turned on and light passes from the light source (26) through the aperture (Fig. 1) (col. 2, lines 34-36);
- Wherein the lighting device (10) illuminates (Fig. 1) (col. 1, lines 19-22) the interior of the article (12) for the purpose of locating items placed within the article (12) by a user.

6. Hill further discloses:

- Wherein the light source is a light bulb (26);
- A reflector (Fig. 3) redirecting light energy received from the luminescent device (26) in a substantially downward direction;
- A coupling (16, 18) securing the lighting device (10) for illuminating, wherein the coupling (16) (col. 2, lines 2-7) attaches the device (10) to the article (12);
- Wherein the housing (Fig. 1) is sized to fit within a hand of a user;

- Wherein the housing (Fig. 3) comprises a top portion (22) a bottom portion (Fig. 2, 18), and the aperture (Fig. 1 & Fig. 3) is formed between the top and bottom of the housing;
- Wherein the article (12) has a compartment divider for separating different compartments (Fig. 1).

7. Applicant argues regarding claims 1, 7 and 23 that the shapes of the article and the lighting device of Hill are not substantially similar (claims 1 and 23) and the housing not have an aperture for a light passage (claim 7). However, the arguments are not persuasive, because both the article (12) and the lighting device (10) of Hill have box shapes with rectangular cross-sections as clearly shown in Figs. 1-3, and there is an apertures in the housing to allow the passage of the light from the recessed light source (26) (Fig. 3) which is clearly shown in Fig. 1.

8. Claims 1-4, 7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Brothers (US 5,975,713).

9. In regard to claims 1 and 7, Brothers discloses a mail box having:

- A light source (16),
- A power supply (34) coupled to the housing (12) and to the light source (16);
- A housing (12) containing the light source (16) and the power supply (34), for insertion into an interior portion of an article (54) having a preselected shape, the housing having a shape substantially similar to the shape of the article (54) (both

article and housing have at least one rectangular cross-section) into the interior of which the light source is attached (Fig. 3);

- Wherein the housing (12) has an interior and an aperture (covered by a clear lens, 30) therein for the passage of light (from the recessed light source, 16);
- Wherein the light source (16) residing in the interior of the housing (12) and coupled thereto (col. 3, lines 12-13);
- A switch (36) coupled to the power supply (34);
- Wherein, when the switch (36) is actuated, the light source (16) is turned on and light passes from the light source (16) through the aperture.

10. Brothers further discloses:

- Wherein the light source is a light bulb (16);
- A reflector (28) for redirecting light energy received from the luminescent device (16) in a substantially downward direction, wherein the luminescent device (16) comprises a light emitting diode (col. 3, lines 14-17);
- Wherein the bottom of the housing (Fig 1) comprises a transparent material (30) for the passage of at least a portion of the light generated by the source (16) (col. 3, lines 12-13).

### ***Claim Rejections - 35 USC § 103***

11. Claims 23-25, 27-30 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biggs et al. (US 5,018,057).

12. In regards to claim 23, Biggs et al. disclose:

- A portable illumination device (10) is secured to a member of an article (12);

- A switch (col. 1, lines 67-68) to activate the illumination device (10).

13. Biggs et al. further disclose:

- Wherein the switch deactivates the illumination device (10) after a predefined timer period (col. 4, lines 29-32);
- A manual actuating a switch (Abstract, lines 5-12);
- Wherein the illumination device is removable and securable to a member and illuminates an area (col. 1, lines 32-36);
- A handbag (12) with a pocket.

14. Biggs et al. does not expressly disclose that the portable illumination device has the shape of the article. It has been held by the courts that a change in shape or configuration, without any criticality, is nothing more than one of numerous shapes that one of ordinary skill in the art would find obvious to provide based on the suitability for the intended final application (see *In re Dailey*, 149 USPQ 47 (CCPA 1966)). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to match the shapes of the illumination device and the article of Biggs et al., for the purpose of providing a more attractive and recognizable set of an illumination device and an associated article (container).

15. Claims 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guerrieri (US 6,848,807).

16. In regards to method claim 23, Guerrieri discloses:

- An illumination device (20);

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- A switch (col. 2, lines 1-4) to activate the illumination device (10) (having a box shape as shown in Fig. 2);

17. Guerrieri further discloses:

- Wherein the illumination device comprise voice recognition circuitry (col. 4, lines 18-21).

18. Guerrieri does not expressly disclose an article having the (box) shape of the device. However, Guerrieri discloses that the device is retained within a briefcase (Abstract, line 7), and it is well known and available knowledge to one of ordinary skill in the art that the briefcase has generally a box shape. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the illumination device of Guerrieri for a briefcase, for the purpose of providing illumination to an interior of the briefcase.

***Allowable Subject Matter***

19. Claims 12-22 are objected because of the informalities noted above, but would be allowable if appropriate corrections are made.

20. Claim 12 is allowable because the prior art fails to show or teach a combination of an article and a lighting device comprising a housing, a light source module and a handle, wherein the article has substantially the same shape as the housing of the lighting device, the light source module is coupled to a top portion of the housing and extends downward, and the handle is attached to the top portion of the housing and secured the lighting device to a member within the article.



21. It is suggested by the Examiner to use "A combination of an article and a lighting device comprising:" as the preamble of claim 12, for the purpose of describing the nature of the invention more clearly.

***Conclusion***

22. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gunyoung T. Lee whose telephone number is (571) 272-8588. The examiner can normally be reached between 7:30 - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea can be reached at (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GTL  
11/8/2006



RENEE LUEBKE  
PRIMARY EXAMINER